

REMARKS

Following the Decision on Appeal dated January 31, 2005, reconsideration and further examination are respectfully requested in view of the foregoing amendments and following remarks.

Status of the Claims

Claims 1, 8, 12 and 19 are amended by this Amendment. Claims 1-22 remain pending in the application.

In the Appeal Decision the Board of Patent Appeals and Interferences (BPAI) formed the claims into four groups, versus the two groups proposed in the Appeal Brief. The BPAI selected a single claim from each of the newly formed groups, directing the new grounds of rejection solely towards the selected representative claim of each group, and mandating that the claims within each newly formed group stand or fall with the chosen representative claim of that group.¹ The BPAI's newly formed claim grouping and new grounds of rejection for each group are as follows:

Group I: claims 1, 3-4 and 8-11 rejected in view of Dazey under §102;

Group II: claims 2 and 5-7 rejected in view of Dazey/Endres under §103;

Group III: claims 12, 14-15 and 19-22 rejected in view of Dazey under §102; and

Group IV: claims 13 and 16-18 rejected in view of Dazey/Endres under §103.

The BPAI initiated new grounds of rejection pursuant 37 CFR §41.50(b) by interpreting Dazey in a manner different than the previous Office Actions of record. Hence, claims 1, 3-4, 8-12, 14-15 and 19-22 remain rejected under §102 in view of U.S. Patent 5,715,415 (Dazey), and claims 2, 5-

¹ Appeal Decision, page 5, lines 14-20.

7, 13 and 16-18 remain rejected under §103 in view of the Dazey patent and further in view of U.S. Patent 6,104,359 (Endres), as set forth in the new grounds of rejection.

Rejection under 35 USC §102 in view of Dazey

Claims 1, 3-4, 8-12, 14-15 and 19-22 are rejected under §102 in view of Dazey. The Appeal Brief argued for patentability, pointing to Figures 3 and 4 of Dazey and col. 5, lines 27-37, which states, in part:

When the help pane 70 is displayed, it encroaches on the workspace 50 and may initially cover a portion of the publication 52. In the illustrated drawing, the help pane 70 covers almost one-half of the workspace 50.

The BPAI noticed what appears to be a scroll bar (unlabelled) along the right side of workspace 50 shown in Figure 4 of Dazey.² In the Appeal Decision the BPAI reasons that the scroll bar apparently defines the right side of the work space 50, assuming that the above-cited passage of Dazey is mistaken regarding its own system.³

This interpretation of Dazey in the Appeal Decision is respectfully traversed. However, in an effort to further the prosecution of the application amendments have been provided herein. For example, claim 1 has been amended to recite a “first display area dedicated to displaying ... an *application program output*” (emphasis added). Previously, claim 1 recited “first display area dedicated to displaying a *main window* of an application program” (emphasis added). It is believed that replacing “main window” with “application program output” will avoid any

² Appeal Decision, page 7, lines 4-6.

³ Appeal Decision, page 7, lines 23-24.

confusion over what was being overlapped in conventional systems. It is believed that the term application program "output" as used in the amended claims and specification (e.g., page 1, lines 33-36) will avoid any confusion with the unlabelled scroll bar in Figure 4 of Dazey. In Dazey the publication 52 -- an application program output -- is clearly overlapped (Dazey, col. 5, lines 27-30).

The present Amendment also incorporates features of dependent claims 8 and 19 into their respective independent claims, claims 1 and 12. Claims 8 and 19 were not considered for patentability in the Appeal Decision which based its decision on the representative claim chosen for each of the four groups of claims.

In addition, the present Amendment amends the independent claims to recite features discussed during the In-Person Interview of March 28, 2005. For example, claim 12 has been amended to recite:

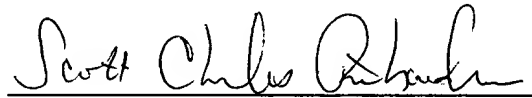
determining an active window from among one or more open windows, the active window displaying the application program output;
making the user request context-sensitive and associating the auxiliary information with the application program based on the determination of the active window.

It is believed that these features are neither taught nor suggested by the prior art. Therefore, reconsideration of the application is requested in view of the claims now pending.

The present Amendment makes a diligent effort to place the claims in condition for allowance. However, should there remain any unresolved issues, the Examiner is kindly invited to contact applicant's representative, Scott Richardson, at telephone number 1.703.739.0573 so that such issues may be resolved as expeditiously as possible.

Respectfully Submitted,

March 29, 2005



Scott Charles Richardson
Reg. No. 43,436

Keady, Olds, Maier & Richardson, PLLC
128 North Pitt Street, 2nd Floor
Alexandria, VA 22314

Tel. 1.703.739.0573